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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,959	05/31/2000	Mark Joseph Hamzy	AUS9-2000-0068-US1	2343

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EXAMINER

CHANG, JUNGWON

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 06/05/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,959

Applicant(s)

HAMZY ET AL.

Examiner

Jungwon Chang

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached-detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-18 are presented for examination.
2. The specification is objected to because the following informalities:
"The are" should be changed to "There are" (please see page 2, line 17).
Appropriate correction is required.
3. It is noted that although the claims contain line numbers, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim beginning with line 1. For ease of reference by both examiner and applicant all future correspondence should include the recommended line numbering.
4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 1. The following terms lack proper antecedent basis:
 - i. the link – claim 13, lines 6-7;
 2. The claim language in the following claims is not clearly understood:

Art Unit: 2154

- i. As to claims 1, 13, 14, 17, 18, line 3, it is not clearly indicated who receives the request for the resource (i.e. data processing system? or server data processing system?);

Line 4, it is not clear who performs the determination (i.e., data processing system? or server data processing system?);

Line 6, it is not clear who sends a different resource to whom.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2154

6. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta (US 6,539,424 B1).

7. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

8. Dutta was cited by applicant dated on 9/5/2000 in IDS paper #2.

9. As to claims 1 and 14, Dutta discloses the invention as claimed, including a method, in a data processing system, for servicing a request for a resource requested by client data processing system (col. 1, lines 7-12; col. 2, lines 60-66), comprising:

receiving the request for the resource (i.e., HTTP GET; 401, fig. 4; col. 2, lines 60-62; col. 5, lines lines 39-42);

determining if the resource requires at least one prerequisite resource (402, fig. 4; col. 4, lines 45-47; col. 2, lines 62-64); and

sending a different resource having a content having a modification of the requested resource if the requested resource requires a prerequisite resource (col. 2, lines 65-66; col. 4, lines 10-23; col. 6, lines 6-10 and 39-44).

Art Unit: 2154

10. As to claims 2-5, Dutta discloses keeping track of each request made for the at least one prerequisite resource for each requester within a tracking parameter (i.e., cookie; fig. 5; col. 3, lines 4-8; col. 4, lines 42-59; col. 5, lines 26-34).

11. As to claims 6 and 7, Dutta discloses determining if a previous request has been made by the requester for the prerequisite resource within the tracking parameter (i.e., cookie; fig. 5) if the requested resource requires a prerequisite resource (col. 5, lines 39-49); and sending different resource if any previous request has not been made (col. 5, line 56 – col. 6, line 10).

12. As to claim 8, Dutta discloses determining which at least one resource is the at least one prerequisite resource (col. 2, lines 65-66; col. 4, lines 10-23; col. 6, lines 39-44).

13. As to claims 9-12, Dutta further discloses modification comprises merging the content of the prerequisite resource with the content of the requested resource (col. 6, lines 39-44; col. 4, lines 10-23; col. 6, lines 6-10 and 39-44; col. 8, lines 8-16).

14. As to claims 13 and 17, Dutta discloses the invention as claimed in claims 1 and 14. In addition, Dutta discloses receiving a different resource than the requested resource if the requested resource was a deep hyperlink wherein the different resource has a content combining the requested resource content with another resource content

Art Unit: 2154

(col. 6, lines 6-10 and 39-44; col. 4, lines 10-23; col. 8, lines 8-16) wherein the link to the requested resource can be reached from the link to the another resource content (col. 4, lines 2-9).

15. As to claims 15 and 16, Dutta discloses keeping tack of each request made for the at least one prerequisite resource for each requester within a tracking parameter (i.e., cookie; fig. 5; col. 3, lines 4-8; col. 4, lines 42-59; col. 5, lines 26-34).

16. As to claim 18, Dutta discloses the invention as claimed in claims 1 and 14. In addition, Dutta discloses a program, having computer readable program code means, on a computer usable medium, for servicing a request for a resource requested by a client data processing system (col. 7, lines 13-20; col. 8, lines 4-16).

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Slemmer, patent 6,226,677 B1, Garrick et al, patent 5,968,125, Kamasaka et al, patent 6,240,455 B1, Tilt et al, patent 6,360,235 B1, Garrick et al, patent 5,968,125 disclose method and system for detecting requests for content from prohibited or restricted URL.

Attention Editors: Deep Link Away, March 30, 2000.

Hoffman, Linking and Crawling Issues, 2001.

Tysver, Linking and Liability, BitLaw A resource on Technology Law, 2000.

Foster, Is Your Web Site Legal?, 2000.

Kaplan, Legality of 'Deep Linking' Remains Deeply Complicated, Cyber Law Journal, April 7, 2000.

Tweney, the tweney report Internet business news and analysis by Dylan Tweney, Billboard economy, Oct. 4, 1999 disclose if a visitor was following a link from an external site (deep hyperlink) that's not on the list of approved partners, simply redirect them to the content provider's home page.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jungwon Chang whose telephone number is (703)305-9669. The examiner can normally be reached on 8:30-6:00 (Monday-Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)308-9052. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-9669.



Jungwon Chang
May 21, 2003

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